



Volume 2, Nos. 7 & 8
July/August 2001

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August is National Inventors Month

August 3 and 4 6th Annual Independent Inventors
9:00am to 5:00pm Conference, Doubletree Hotel,
Arlington, Virginia

Office of Public Affairs
Washington, DC 20231
703/305-8341

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Comments and suggestions are welcome by e-mail to ruth.nyblod@uspto.gov.

The Magazine of the United States Patent and Trademark Office



Nicholas P. Godici

Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office

A number of significant events in recent months have exemplified the United States Patent and Trademark Office's progress in moving toward an electronic environment.

Use of the Trademark Electronic Application System (TEAS) continues to grow. On June 25, we celebrated the 100,000th electronically filed trademark application with a presentation to General Electric, who filed the application. In May, the USPTO was selected as a finalist for the *USA Today*'s 2001 Quality Cup Award for the TEAS system. TEAS was recognized as a high-quality and innovative customer service tool that makes it easier for Americans to do business with the federal government. In the past 14 months, TEAS also has been recognized for excellence in two other national competitions. In May 2000, TEAS was selected as a semifinalist in the 2000 Innovations in American Government Awards Program, a competition sponsored by The Ford Foundation, The John F. Kennedy School of Government at Harvard University, and The Council for Excellence in Government. In October 2000, TEAS was selected for the 2000 Government Technology Leadership Award sponsored by *Government Executive Magazine*.

The patent business also has taken an important step toward operating in an electronic environment. The Office of Personnel Management (OPM) approved the "Agreement on Initiatives for a New Millennium" on May 31, 2001. This agreement provides the Patent business with the flexibility necessary to recruit highly skilled professionals and retain experienced employees who will help the agency move forward toward electronic-based processing, enhancing customer service, and enhancing quality.

This historic agreement is the result of a cooperative effort by the Patent Office Professional Association and USPTO management. This is a significant accomplishment for the agency.

The agreement addresses a number of long-standing issues and will help the Patent Organization reach its goals. The agreement includes a special pay rate to address

recruitment and retention issues for patent examining professionals, moving to an electronic searching environment by the phased elimination of paper search files, improving automation tools, establishing a patent examiner work-at-home pilot, and adding a customer service element to employees' performance plans. Together, these items will positively impact quality, customer service, and timeliness.

The Trademark business is also being recognized as one of the leaders in the federal government in telecommuting. I am very proud to announce that the USPTO received the Metropolitan Washington Council of Governments 2001 Commuter Connections Telework Award. The award recognizes our Trademark Work at Home Program, which has grown from a pilot of 18 participants to a full program with 90 current participants working at home at least three days per week. Anne Chasser, Commissioner for Trademarks, accepted the award on behalf of the USPTO at a ceremony on June 27 at the National Press Club in Washington D.C.

All of these events represent milestones in our progress and commitment toward improving the USPTO for both our customers and our employees.

This month in history...

July 14: Patent No. 322,177 was granted in 1885 to Sarah E. Goode for a folding cabinet bed. She was one of the first African-American women to obtain a U.S. patent.

July 31: The first U.S. patent was issued in 1790 to Samuel Hopkins for "making pot and pearl ashes," a cleaning formula then used in soapmaking.

August 18: Plant Patent No. 1 issued in 1931 to Henry F. Bosenberg of New Brunswick, NJ, for "a climbing rose... characterized by its everblooming habit."

August 30: Patent No. 610,040 granted to Henry Ford of Detroit, MI, in 1898 for "new and useful improvements in carburetors...." Ford obtained a total of 161 U.S. patents.

100,000th Trademark Electronic Application Filed

by Kevin Cope, Office of the Commissioner for Trademarks

On Monday, June 25, 2001, the United States Patent and Trademark Office recognized the 100,000th trademark application filed using the Trademark Electronic Application System (TEAS) with a celebration ceremony in the Patent and Trademark Museum. General Electric filed the 100,000th electronic trademark application on June 4, 2001, for a typed form of the mark “GE.” GE has registered or applied for more than 1,300 trademarks.

Commissioner for Trademarks Anne Chasser noted that while Internet technology is becoming increasingly essential, “It is still people that make things happen.” Chasser recognized many of the individuals involved in the success of the TEAS endeavor, as well as introducing representatives from one of the USPTO’s partners in success: The General Electric Company.

Representatives from GE, Ron Myrick, Chief Intellectual Property Counsel, and Katherine Barrett Park, Trademark Counsel, accepted a commemorative plaque, remarked on the merits of e-filing, and performed an actual electronic filing during the ceremony.

Katherine Barrett Park spoke of the added benefits of e-filing for GE, including the reduced waiting time and increased efficiency that her company had experienced with the implementation of the new system. She said that the system has helped them improve communications with businesses, has decreased expenditures on outside counsel fees, and has perfectly complemented GE’s corporate initiative of digitization.

In the early 1980s, Gerald Mossinghoff, then Assistant Secretary of Commerce and Commissioner of Patents and Trademarks, envisioned a “paperless” office – one in which communication was instantaneous, material waste and clutter were negligible, and high efficiency and first-rate customer service were the standard. USPTO is one of the first government agencies to move toward e-government and is realizing Mr. Mossinghoff’s vision with its TEAS.

Acting Under Secretary for Intellectual Property and Acting Director of the USPTO Nicholas Godici added that the USPTO is the only national intellectual property office in the world that offers electronic filing for trademarks and patents 24 hours a day, seven days a week. Godici explained that this innovation came about largely because of customer feedback and the USPTO’s commitment to its customers.

In concluding the ceremony, Chasser stated that she looks forward to celebrating the one-millionth electronically filed trademark application. At first, this may seem like a daunting goal. However, given the USPTO’s commitment to constantly

improving TEAS, its existing record of rapid success with the system, and its vision to lead the world in e-government innovation, this next milestone may be here before we know it.

USPTO Requests Public Input on Business Method Prior Art

by Wynn Coggins, Industry Outreach Coordinator, Technology Center 2100

Examiners are taught early that searching and using the best prior art to support a position are critical steps in the examination process. However, finding the best prior art has become a challenge to the examiners working in Class 705, the business methods area of the Patent Operation. This is due to the fact that much of what is considered the best prior art does not exist as a patent, but instead is found in non-patent literature.

Non-patent literature (NPL) encompasses a wide variety of diverse published materials, such as textbooks, newspaper articles, magazine articles, sales brochures, professional journals, and conference proceedings. While a patent examiner working in other areas of the United States Patent and Trademark Office can find art in the U.S. patent databases, these databases contain a smaller percentage of the relevant prior art in rapidly emerging technologies such as business methods. Thus, examiners searching cases in Class 705 rely heavily on NPL to provide the relevant art in these areas.

Mandatory Searching

Examiners in Class 705 are required to perform a mandatory search of classified U.S. patent documents, and a text search of U.S. patent documents, foreign patent documents, and non-patent literature. The NPL searches include required search areas mapped/correlated to the U.S. classification system for Class 705.

To assist the examiner in searching for scientific and business related NPL, the USPTO provides access to over 900 available databases such as the Software Patent Institute [SPI], IEEE/IEE Electronic Library [IEL Online], etc. However, there may be relevant prior art that is not available through these over 900 databases. Thus, the USPTO is currently receiving and cataloging feedback of current prior art resources, and soliciting input on possible ways to expand these resources to include other databases and information collections that are not available to the

examiners in Class 705. As a part of these efforts, a *Federal Register* Notice was published on June 5, 2001, which requested input from interested parties on additional sources of prior art that the USPTO could utilize in the examination of applications in Class 705. A full and complete listing of the current core databases for Class 705 is provided in the notice for comment, along with a detailed description of the mandatory search that is now required for all applications examined in Class 705.

The request for comments on the agency's prior art databases is another component of USPTO's March 2000 Business Method Initiative. By partnering with the public and other interested parties to identify and use additional sources of business method prior art that are not currently available or known to the USPTO, the agency will improve its abilities to examine applications and ensure high-quality patents in this fast-emerging technology.

The USPTO has experienced substantial growth in patent application filings for computer-implemented processes related to electronic commerce. Applications for software-implemented business method patents grew from 170 in 1999 to 7,800 in 2000. Last year USPTO issued 899 business method patents.

Complete information about the business method patent databases can be found at www.uspto.gov/web/offices/com/sol/notices/ab26.html.

We Do Make A Difference

by Richard J. Apley, Director, Office of Independent Inventor Programs

I just received my 35-year service pin. It had to be a mistake. I almost returned it because I couldn't believe that 35 years had gone by so quickly. Thirty-five years of patent examining, supervising patent examiners, and training patent examiners and independent inventors in the prosecution of patent applications.

During my presentations to inventors and inventor organizations, I am frequently asked how I was able to do my job for 35 years and not get burned out. Until recently, I responded by giving a standard and traditional answer of being dedicated to the job, etc., but it was beginning to sound like a boring mantra. I then realized that I was suffering from the dreaded disease called "burnout." The job had finally got me down. On one of my trips, I read an article entitled "Don't Burn

Out!” It began by questioning your current attitude.

“Are you feeling tired, tattered, tested, bested, toasted, and roasted? Are you looking for something to pick you up, slow you down, lift your spirits, drop your burden, make you smile, help your style? Take the next few minutes to sip a cup of mint tea, to listen to your favorite recording... and to read the tips and tactics of ... 15 ... sages, your peers in the relentless race to the future. All of them are superbusy superbodies, and although they’ve suffered some bumps and bruises along the way, they’ve developed a few important tricks in the art of self-regeneration. They’ve vowed not to burn out, and they’re learning how to keep the fires burning.”

After reading the 15 “tips and tactics” from the experts, I was still discouraged but realized that I was not alone. And then I read an article about Ivan Yaeger, an independent inventor. It was his patented invention of an artificial arm and hand that helped 11-year-old Diamond Excell hug her mother for the first time. Why was this simple act so significant to Diamond and her mother? Diamond was born with a congenital deformity that left her without shoulders, arms, or hands. She learned to perform normal tasks with her feet – eating, writing, and even cooking. When her bionic arms were fitted to Diamond’s torso, she gleefully yelled that she was ready to do it – the “it” being months of therapy, practice, and fittings. The bionic arm has batteries, sensors, wires, and microprocessors that pick up nerve signals from electrodes placed at key points on Diamond’s torso. The electronics then translate nerve signals generated by muscle movement into signals that move the bionic arm and hand.

Diamond Excell hugged Ivan Yaeger after she received her artificial arms and made his life’s work worthwhile. Ivan Yaeger patented his device in 1987 when he was a senior in high school and has continued his involvement in inventing and instructing school children about the process of inventing. His message is simple: “Don’t be afraid to dream.”

This story started to make me feel good about the work we do at the United States Patent and Trademark Office. I went to Miami to talk to Ivan Yaeger and to somehow capture his spirit. It was to be my pilgrimage for renewal. The rest of the story was inspired by Ivan’s love of inventing and helping children cope with their problems.

The USPTO is on the cutting edge of technological progress, where the abstract dreams of independent inventors are translated into the practical realities of patent and trademark applications. The men and women of the USPTO play an extremely important role in the lives of these inventors. The employees of the USPTO, whether managerial, professional, tech support, or administrative, are the link between an inventor’s imagination and the marketplace where new ideas are constantly being introduced.

The job we have at the USPTO requires a rare mixture of skills and abilities. It requires attention to detail; the ability to solve problems and make decisions within a framework of time constraints and production goals; and it expects you to have compassion for the inventor behind the file wrapper. The USPTO attracts people who want to help inventors.

Inventors, and the nation, can feel reassured that the USPTO continues to attract bright and dedicated people. It attracts the kind of person who likes a challenge. A person who knows that an inventor's imagination gives us a preview of life's coming attractions. A person who wants to be part of the future by helping invent it. A person who knows that all human knowledge doesn't come from books. A person who can make the difference in providing hope to others lives.

I finally felt renewed. My fire had been rekindled.

I looked up Ivan Yaeger's patent: 4,685,928. I smiled. The primary examiner was Richard J. Apley.

From 1,500 miles away I felt that Diamond Excell had hugged me, too.



Ivan Yaeger (L) and Richard Apley at the Yaeger Foundation in Miami, Florida.

Helpful Hints

for patent applicants...

Support Your Local Inventor

by Richard J. Apley, Director, Office of Independent Inventor Programs

Have you ever wondered what separates the hopeful from the hopeless? For inventors, the line between the two is a fragile element called “support.” Before an inventor can bring his/her idea to the market, it goes through an evolutionary process. It is often shelved, sidelined, or abandoned at the first bump in the road. It is the unusual inventor who stumbles upon a “sure fire winner.” The odds are great that the invention arrives with the right combination of timing, luck, financing, and public need.

This August, the Office of Independent Inventor Programs will hold its 6th Annual Independent Inventor Conference to coincide with “National Inventors’ Month.” This effort is being coordinated by Joanne Hayes-Rines, editor and publisher of *Inventors’ Digest: The Magazine for Idea People*.

Joanne Hayes-Rines views this as nothing less than a crusade stating that inventors need this type of recognition and support. Joanne put it this way:

“Albert Einstein once said, “Imagination is more important than knowledge....” Those creators, tinkers, geniuses - those with imaginations that have “run wild” – are at the heart of this month’s national celebration of inventors. National Inventors’ Month was established in August 1998 to recognize the brilliant efforts and entrepreneurial spirit of independent inventors. ... During August... (libraries throughout the country) ... will display materials highlighting the achievements of those inventors who dare to be blatantly creative, and whose accomplishments affect every facet of our lives.[I]nventors through the ages have worked tirelessly, motivated solely by the pursuit of a passionate dream. Facing naysayers, failures, limited resources, patent infringements, ridicule and scorn, only a few succeed. National Inventors’ Month was created to recognize the achievements of those inventors, who, through their efforts, have enriched and extended our lives.”

The United States Patent and Trademark Office established the **Office of Independent Inventor Programs (OIIP)** in 1999 with the primary mission to ensure

continued support and encouragement of independent inventors through focused, innovative activities and projects. One of these innovative activities is a regular review of office rules and procedures to simplify the process. One such example is amended Rule 37 CFR 1.121 – Amendment by Replacement Paragraph/Section/Claim. Effective March 1, 2001, this rule provides for the amendments of the specification/claims by replacement paragraphs/sections/claims. OIIP was a proud sponsor of this rule change because it eliminated handwritten red-ink amendment entries and claims with underlining and bracketing. The clean text in specifications and claims facilitates OCR scanning in patent publication whereby printed patents should have fewer errors, and it will improve the efficiency of the technical support staff when used in conjunction with the optional feature of numbered paragraphs.

How to make amendments to the specification:

1. The text of any added (new) or deleted paragraph does not have to be presented in any marked-up version (with underlying and bracketing); an indication that the paragraph has been added or deleted is sufficient, e.g., “The paragraph beginning at p.2, line 6, has been deleted.”
2. Submit a clean (i.e. with no underlying or bracketing) amended paragraph/section with an instruction to substitute it for the pending paragraph/claim.
3. Identify the pending paragraph/section to be replaced by any clear instruction (e.g., if you number your paragraphs then the instruction would be, for example, paragraph [0045]; or the paragraph beginning on page x, line y; or the 3rd full paragraph on page 3; etc.).
4. Also, you must submit a marked-up version of the prior pending paragraph/section with all changes shown by any conventional comparison system.

How to make amendments to the claims:

1. Submit a clean (with no underlining and bracketing) amended claim with an instruction to substitute it for the pending claim with the same number; also submit a marked-up version of the prior pending claim with all changes shown by any conventional comparison system.
2. Any new or canceled claim does not have to be in marked-up version; an indication that claim X is new or claim Y was canceled is sufficient.
3. Both the clean amended claim and the marked-up version should have the same expression: “amended,” “twice amended,” etc., in parentheses after the claim number [therefore, the claim would appear as follows: Claim Z (amended)].
4. A clean set of all pending claims with the same numbers as the pending claims being re-presented can be submitted at any time. This type of submission will be construed as directing the cancellation of all previous versions of the re-presented claims. Remember that the absence of an accompanying marked-up version constitutes an assertion that the claim has not been changed relative to the immediate prior version.
5. A claim may be canceled by an instruction; for example, cancel claim 3.
6. A canceled claim can be reinstated only by re-presentation of the complete text of the claim with a new claim number.

Rule 1.125: Substitute Specification

1. When a substitute specification is submitted, it must be submitted in clean form and must be accompanied by a marked-up version showing the changes made.
2. It is recommended that the paragraphs be numbered.

Hint for making amendments:

Whenever you are submitting a clean copy of an amendment and a marked-up version of the changes, it is recommended that you use a separate page for the marked-up version and title it: **Version With Markings To Show Changes Made.**

Patent Application Publications as Prior Art [a legal lecture]

{revised August 6 from original posting}

by Robert Clarke, Legal Advisor, Office of Patent Legal Administration

The American Inventors Protection Act of 1999 provided for the publication of most plant and utility patent applications filed on or after November 29, 2000, following the expiration of an 18-month time period measured from the earliest date for which benefit is claimed under Title 35 of the United States Code. Applicants that have not filed abroad or under an international agreement, and will not do so, may on filing of an application on or after November 29, 2000, request that their applications not be published. About 12,000 applications have been published to date. Less than 10 percent of applications include a request for non-publication. Assuming no change in the percentage of applicants that request non-publication, it is reasonable that within the next year, roughly 90 percent of all plant and utility applications filed after November 29, 2000, will be published.

The patent statute in 35 U.S.C. §§ 102 (a), (b), and (e) provides that an applicant is not entitled to a patent if a printed publication: (1) qualifies as prior art under one of those sections as to that particular application for patent, and (2) discloses the invention as claimed by applicant. Similarly, in 35 U.S.C. § 103(a) the patent statute provides that an applicant is not entitled to patent if the differences between the subject matter sought to be patented and the prior art would have been obvious to one skilled in the art at the time the invention was made. Printed publications that qualify as prior art under 35 U.S.C. § 102 as to a particular application are also to be considered as prior art under 35 U.S.C. § 103(a) unless the conditions of 35 U.S.C. §§ 103(b) or (c) apply.

The new patent application publications are available against certain applications as prior art under 35 U.S.C. 102 §§ (a), (b) or (e). In order to determine whether a certain patent application publication may be applied against a particular application under 35 U.S.C. § 102(a), the examiner need only compare the application's date of publication to ensure that it is before the effective filing date or earliest priority date to which the applicant is entitled and determine if the publication is to "another" compared to the applicant for patent. Assuming that the application (or any intermediate application) was not filed as a continuation in part of a prior application and that no benefit of a prior foreign or provisional application's filing date is claimed, then the examiner may simply compare the publication date of the publication reference with the earliest filing date claimed by applicant. If the publication date is earlier and the reference is to another, then it is *prima facie* prior art under 35 U.S.C. § 102(a). A determination of whether the disclosure of the prior art discloses the invention claimed by applicant must then be made before a rejection under 35 U.S.C. § 102(a) is made.

When examining an application that is filed as a continuation in part of a prior application or which claims benefit to an application which was filed as a continuation in part of a prior application, special care is required. Benefit of the earlier filing date may be given on a claim-by-claim basis only where the disclosure of the earlier application provides adequate written support for each claim. For example, a broad claim in an application filed as a continuation in part may be supported by disclosure of the prior relied upon application, while a narrower claim may be supported only by the newly disclosed subject matter. In such an instance, the broader claim is considered as "filed" for prior art purposes on the date the prior relied upon application was filed, while the narrower claim is considered filed for prior art purposes on the date of the application which included the newly disclosed subject matter. Each date should be compared with a publication date of a document. Where a document is published prior to the date of filing of the application with the newly disclosed matter but after the relied upon date of the parent application, only the narrower claim should be rejected under 35 U.S.C. § 102(a).

Similarly, where an application claims the benefit of a prior foreign or provisional application, it is important to determine which claims are supported in the prior application as claims that find support only in the non-provisional application may be rejected based on a document published after the relied upon date but prior to the non-provisional application's filing date. Where the prior application is in a foreign language, the examiner should require both a certified copy of the foreign application as well as a translation into English if the applicant relies on the benefit of foreign priority to overcome a prior art rejection.

Under 35 U.S.C. § 102(b) an applicant is not entitled to a patent if the claimed invention was disclosed in prior art published more than one year before the earliest U.S. filing date to which an applicant is entitled. Thus, when reviewing an application, an examiner must compare the earliest U.S. filing date to which an applicant is entitled with the date of publication. Unlike the review under 35 U.S.C. § 102(a), whether the document is by another or not is not relevant.

Only U.S. filing dates are considered when reviewing the prior art under 35 U.S.C. § 102(b). Earlier foreign applications for which applicant is entitled to priority benefits do not provide any protection. Thus, when examining a utility application that was filed on April 1, 2002, that claims benefit to a foreign application filed on April 2, 2001, a patent application publication published on March 15, 2001, would be prior art under 35 U.S.C. § 102(b), while one published on April 15, 2001, would not.

Under 35 U.S.C. 102(e)(1), applications for patent published under 35 U.S.C. 122(b) are available as prior art against application filed on or after November 29, 2000, and against applications voluntarily published under 35 U.S.C. 122(b). See Pub. Law 106-113 § 4508, second sentence. These applications, including a Continued Prosecution Application (CPA) filed on or after November 29, 2000, are not entitled to a patent if, prior to their invention, another files an application that is published pursuant to 35 U.S.C. § 122(b).

Therefore, when reviewing the prior art for applications filed after November 29, 2000, or an application that is voluntarily published, an application publication that resulted from an application by another that was filed prior to the effective U.S. filing date or a foreign filing date that applicant is entitled to the benefit of under 35 U.S.C. §§ 119(a)-(d), and which discloses the invention claimed in the application under review, should be used in a rejection of those claims. For a patent application publication that resulted from an application that does not mature directly or indirectly from an international (PCT) application, the determination of whether an application publication resulted from an application filed prior to an application under review is the same as the analysis that was given to a U.S. patent when reviewing applications filed prior to November 29, 2000. Therefore, an application publication that resulted from an application which appropriately claimed the benefit of a prior U.S. application's filing date would be considered "filed" as of the date of the prior application, assuming that the prior application provided adequate written support for the relied upon subject matter. Conversely, where the application publication resulted from an application which claimed the benefit of a prior foreign, but not international, application, the application publication would be considered "filed" for purposes of 35 U.S.C. § 102(e)(1) as of the date of filing of the U.S. application and not the earlier foreign application.

Assuming that no change to 35 U.S.C. § 102(e)(1) is made by Congress, for an application publication that resulted from an application that matured directly, *i.e.*, is a National Stage application under 35 U.S.C. § 371, or indirectly, *i.e.*, claims benefit under title 35 of a prior International Application, from an international application, it is important to determine the language and type of publication that the International Bureau provided for the International Application in order to determine the date the application publication was "filed" for purposes of 35 U.S.C. § 102(e)(1). In the instance where the International Application, which is either the national stage of the application which has been published by the USPTO or which International Application's filing date is appropriately relied upon by the application which has been published by the USPTO was published by

the International Bureau in English pursuant to PCT Article 21(2)(a), *i.e.*, publication occurs 18 months from the earliest claimed date, then the application publication is considered “filed” for purposes of 35 U.S.C. § 102(e)(1) as of the International Application’s filing date, for all of the common subject matter between the International Application and the application publication. Moreover, if the International Application and the application that resulted in the application publication both appropriately claim the benefit of a prior U.S. application and the relied upon subject matter is supported in all of the applications, the publication would be considered “filed” in the United States as of the date of the prior U.S. application.

Conversely, where the International Application, which is either the national stage of the application which has been published by the USPTO or which International Application’s filing date is appropriately relied upon by the application which has been published by the USPTO, was **not** published by the International Bureau in English pursuant to PCT Article 21(2)(a), then the application publication is not considered “filed” for purposes of 35 U.S.C. § 102(e)(1) as of the International Application’s filing date, for all of the common subject matter between the International Application and the application publication. Thus, an application publication that results from the National Stage of such International Application would not be considered “filed” in the United States for purposes of 35 U.S.C. § 102(e)(1). Moreover, in the instance where such International Application and the application that resulted in the application publication claim the benefit of a prior U.S. application, the application publication would not be considered filed in the United States on the date of the prior U.S. application, except where the application which resulted in the application publication may appropriately rely upon the prior U.S. application without reliance on the pendency or filing of the International Application.

When reviewing applications filed on or after November 29, 2000, or an application voluntarily published, it is also important to review International Application publications. As with applications filed prior to November 29, 2000, all International Application publications were usable as prior art under 35 U.S.C. § 102(a) and (b) and therefore must be analyzed as set forth above. Unlike applications filed prior to November 29, 2000, when reviewing applications filed after November 29, 2000, it is important to determine that no International Application publication exists that: (1) was filed on or after November 29, 2000; (2) resulted from an International Application that designated the United States; (3) was published in English pursuant to PCT Article 21(2)(a); (4) entered the National Stage as to the United States; (5) resulted from an International Application to another; and (6) disclosed or rendered obvious the invention claimed in the application under review. If an International Application meeting all six items above is discovered, the publication should be considered “filed” for purposes of 35 U.S.C. § 102(e)(1) as of the international filing date, or a prior relied upon U.S. filing date for any common subject matter, and a rejection under 35 U.S.C. §§ 102(e)(1) or 103, as appropriate, should be made.

Faces of the USPTO

Jasemine C. Chambers, Ph.D., J.D. is a director in Technology Center 1600 at the United States Patent and Trademark Office. In this capacity, she leads a team of managers and patent examiners in the examination of biotechnology, pharmaceuticals, and organic chemistry patent applications.

Ms. Chambers joined the USPTO in 1988 as a patent examiner. She served on a career development detail in the Office of the Deputy Assistant Commissioner for Patent Policy and Projects from 1993 to 1994 and was selected as a supervisory patent examiner in 1996. Ms. Chambers was instrumental in the development of policies and procedures for the examination of patent applications for such complex biotechnology inventions as human gene therapy, transgenic animals, and expressed sequence tags of the human genome.



In 1998, Ms. Chambers was selected as a Commerce, Science and Technology (ComSci) Fellow. During this time, Ms. Chambers worked as a senior policy analyst at the White House Office of Science and Technology Policy. Her duties included a range of issues related to international policy, particularly as science and technology supports the nation's goals of national security, economic growth, and global stability. Upon completion of her assignment at the OSTP, Ms. Chambers returned to the USPTO in 1999 and resumed her position as a supervisory patent examiner. She was appointed as a director in Technology Center 1600 in 2000.

Prior to joining the USPTO, Ms. Chambers was a senior staff fellow at the National Institutes of Health from 1986 to 1988 and a postdoctoral fellow at the Duke University Medical Center from 1982 to 1986. Her research experience included the study of central nervous system diseases and gene therapies using transgenic mouse models, the study of autoimmune diseases via cloning and expression of autoantigens, and the interaction of autoantigens with cellular and viral RNAs and DNAs. She has coauthored more than 15 peer-reviewed scientific publications.

During her tenure at the USPTO, Ms. Chambers has received numerous awards including a Department of Commerce Bronze Medal, an Exceptional Career Award, and an EEO Director's Award from the USPTO, an Outstanding Service Award from the Patent and Trademark Office Society, and an Outstanding Contribution Award from the American Intellectual Property Law Association.

Ms. Chambers holds a B.A. with High Honors in Biology from Agnes Scott College, a Ph.D. in Molecular Biophysics from the Florida State University, and a J.D. with Honors from the George Washington University Law School. She is a member of the Maryland State Bar. Ms. Chambers resides in Bethesda, Maryland, with her husband and their three daughters, ages 13, 9, and 7.

John Doll has been with the United States Patent and Trademark Office for 27 years. John received his BS in Chemistry and Physics from Bowling Green State University and his MS in Physical Chemistry from Pennsylvania State University. As a patent examiner, in Art Unit 117, he examined applications encompassing pharmaceuticals, herbicides, pesticides and dyestuffs. As a supervisory patent examiner, in Art Units 113, 189B and 1806, he was responsible for the examination of applications drawn to a variety of arts including inorganic chemistry, hydrometallurgy, zeolite catalysts, semiconductor precursors, buckminsterfullerenes, proteins, and peptides. In 1992, he became the deputy director of Group 110, the Chemical/Chemical Engineering Patent Examination Group, and in 1995, he became the director of Group 1800, the Biotechnology Patent Examination Group.



In 1995, John directed the development and implementation of the 35 USC 101 Utility Guidelines, and in 1996, he directed the development and implementation of the 35 USC 112, paragraph 1, Enablement Examiner Training Materials. For the past several years, he has been intimately involved with the development and implementation of the 35 U.S.C. 101 Utility Guidelines and the 35 USC 112, paragraph 1, Written Description Guidelines, as well as the associated Examiner Training Materials.

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